

REMARKS

Applicant has studied the Office Action dated April 25, 2007 and has made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. Claims 1-20 are pending. Claims 1, 2, and 4-20 have been amended. Reconsideration and allowance of the claims in view of the above amendments and the following remarks are respectfully requested.

Claims 10-16 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. Applicant has amended claim 10 to recite a "computer readable medium encoded with a program for providing automatic recurring online payments." Additionally, amended claim 10 further specifies that "the program compris[es] instructions for execution by a processing circuit for performing . . . steps." In light of this amendment, it is respectfully submitted that the rejection of claims 10-16 under 35 U.S.C. § 101 should be withdrawn.

Claims 1-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ensel et al. (U.S. Patent No. 6,493,685). This rejection is respectfully traversed.

The present invention is directed to an efficient and easy-to-implement method for providing prompted automatic recurring online payments. One embodiment of the present invention provides a method for providing automatic recurring online payments. According to the method, instead of immediately executing a payment according to a recurring schedule, a notification is sent to the user before an automatic recurring payment is executed. More specifically, there is received from a user an automatic recurring online payment configuration that includes an amount and an interval for executing a plurality of automatic recurring payments.

In response to determining that one of the automatic recurring payments is to be executed based on the automatic recurring online payment configuration, a notification is sent to the user to notify the user that the one automatic recurring payment is to be executed. This notification is sent to the user before the one automatic recurring payment is executed. It is determined whether or not to execute the one automatic recurring payment based on a response received from the user and/or a

lack of a response from the user within a specified period of time. Because the user is notified when a payment is to be executed, the user can decide whether or not to have the payment executed as previously planned. Thus, the convenience of having the system automatically remember recurring payments is still provided, but more control over the payments is maintained by the user.

The Ensel reference is directed toward an information interface provider (“IIP”) that acts as an interface between a billing entity and its customers. The IIP presents electronic bills to customers and processes payments made by the customers. The IIP maintains a Billing-entity Acquisition Platform (“BAP”) which is a staging area that facilitates presentment of bills to the billing entity's customers via a communication mechanism such as email and facilitates payment via any accepted payment mechanism. The customer can select how bills are to be presented and the IIP then transmits the bills through that channel. The IIP insulates the billing entities from the physical tasks of presenting the bills to the customers and processing the payments from the customers.

The IIP receives the billing data from the billing entity, formats the billing data for storage, and then formats the bill for the desired channel of distribution. With regard to payments, customers can pay in different manners such as by credit card or paper checks, and the IIP can also track preauthorized payments of certain bills. For preauthorization, the customer first authorizes the IIP to recurrently debit a selected account to pay a bill (or bills), typically a recurring bill that is always for the same amount (e.g., a mortgage payment). Once payment has been preauthorized, whenever the preauthorized payment for that bill is due, the IIP debits the selected account and credits the account of the billing entity.

Amended claim 1 recites:

receiving, from a user, an automatic recurring online payment configuration that includes an amount and an interval for executing a plurality of automatic recurring payments;

determining that one of the automatic recurring payments is to be executed based on the automatic recurring online payment configuration;

in response to determining that the one automatic recurring payment is to be executed, sending a notification to the user to notify the user that the one automatic recurring payment is to be executed, the notification being sent to the user before the one automatic recurring payment is executed; and

determining whether or not to execute the one automatic recurring payment based on at least one of a response to the notification received from the user and a lack of a response to the notification from the user within a specified period of time.

Amended claims 10 and 17 contain similar recitations.

The Examiner asserts that Ensel teaches “sending a notification to the user of a pending automatic payment based on the automatic recurring online payment configuration”. According to the Examiner, at column 14, lines 30-34 Ensel discloses delivering secure email notices of bill availability. More specifically, Ensel discloses the following at column 14, lines 30-38.

In presenting E-Bills via Email, the BAP 200 is capable of delivering secure Email notices of bill availability and providing a hotlink to an appropriate web site, or the BAP can deliver secure bills directly via Email. The Email capability of the BAP 200 includes conforming to all standard Email Protocols (STMP, MIME, SMIME . . .). Without requiring software on the customer's Desktop, the BAP can certify that the Email was read, return secure payment instructions from the customer 80 via Email.

In contrast, embodiments of the present invention determine that an automatic recurring payments is to be executed based on an automatic recurring online payment configuration. And, in response to determining that an automatic recurring payment is to be executed, a notification is sent to the user to notify the user, before the one automatic recurring payment is executed, that the one automatic recurring payment is to be executed. Nowhere does Ensel teach these claimed features of the present invention. The system of Ensel does not notify a user in response to determining that an automatic recurring payment is to be executed. Therefore, Ensel cannot possibly teach or suggest sending such a notification before an automatic recurring payment is executed. The portion of Ensel cited by the Examiner (and elsewhere throughout Ensel) is directed toward notifying a user of a bill, not of an automatic recurring payment that is to be executed. Sending an email containing a bill is very different from sending a notification to notify the user that an automatic recurring payment is to be executed. In embodiments of the present invention, the user is notified of an automatic recurring payment before that automatic recurring payment is executed. This allows the user to confirm, modify, cancel, or otherwise react to the payment before it is made.

Further, the Examiner asserts that Ensel teaches “determining whether or not to execute the pending automatic payment based on at least one of a response to the notification received from the user and a lack of a response to the notification from the user” by disclosing “accomplishment by the payment processor of payment processing by executing customer payment instructions”, that “responses can include any type of response or instruction from a customer”, and “an embodiment capable of processing negative responses or any type of response or instruction from a customer . . . or initiating the automatic payments prescribed in the enrollment profiles including pre-authorizations without an initiative required by the customers”.

As explained above, Ensel does not teach sending a notification to the user to notify the user that an automatic recurring payment is to be executed before that automatic recurring payment is executed. Therefore, Ensel cannot possibly teach determining whether or not to execute a payment based on a response to such a notification received from the user and/or a lack of a response to such a notification from the user within a specified period of time. With respect to automatic payments, Ensel only discloses executing such payments without the user having to initiate the payment. This is the standard manner in which conventional payment systems are configured (see background section of the specification).

Ensel only teaches presenting bills to a user and paying the bill based on user preauthorization or user payment instructions. Automatic payments in Ensel are merely payments that are executed without prior user intervention. This is very different than sending a notification to the user before an automatic recurring payment is executed, and then determining whether or not to execute that automatic recurring payment based on a response and/or lack of a response from the user. Ensel does not teach or suggest determining whether or not to execute an automatic recurring payment based on a response to the notification received from the user and/or a lack of a response to the notification from the user within a specified period of time.

Applicant believes that the differences between Ensel and the present invention are clear in amended claims 1, 10, and 17, which set forth various embodiments of the present invention. Further, claims 2-9, claims 11-16, and claims 18-20 depend from amended claims 1, 10, and 17, respectfully. Thus, claims 2-9, 11-16, and 18-20 distinguish over Ensel as well. Therefore, claims 1-20 distinguish over the Ensel reference, and the rejection of these claims under 35 U.S.C. § 102(b) should be withdrawn.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Applicant has examined the references cited by the Examiner as pertinent but not relied upon. It is believed that these references neither disclose nor make obvious the invention recited in the present claims. In view of the foregoing, it is respectfully submitted that the application and the claims are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is invited to call the undersigned attorney at (561) 989-9811 should the Examiner believe a telephone interview would advance the prosecution of the application.

Respectfully submitted,

Date: July 25, 2007

By: /Stephen Bongini/
Stephen Bongini
Reg. No. 40,917
Attorney for Applicant

FLEIT KAIN GIBBONS
GUTMAN BONGINI & BIANCO P.L.
One Boca Commerce Center
551 Northwest 77th Street, Suite 111
Boca Raton, Florida 33487
Telephone: (561) 989-9811
Facsimile: (561) 989-9812